

view of Rutledge et al. (U.S. Patent No. 5,188,580). The Examiner also rejected claim 43 using these two references.

In the October 20, 2003 Amendment, Applicants argued that one skilled in the art would not have been motivated to combine McCole and Rutledge et al. in the absence of the present application. In the July 31, 2003 Office Action (as well as in this Office Action), the Examiner acknowledged that McCole does not teach or suggest having a “free loop” disposed in a feed region as recited in claim 30. To cure this acknowledged deficiency, the Examiner proposed to combine McCole with Rutledge et al., that show a “free loop” used in a plastic bag manufacturing apparatus.

Nonetheless, Applicants respectfully submit that the Examiner has not presented persuasive arguments necessary for a *prima facie* case of obviousness. That is, there is no motivation to combine McCole and Rutledge et al. Specifically, most if not all inventions arise from a combination of old elements. *In re Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000) (*citing In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998)). Thus, every element of a claimed invention may often be found in the prior art. *Id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. *Id.* Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. *In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000) (*citing In re Dance*, 160 F.3d 1339, 1343 (Fed. Cir. 1998); and *In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984)).

In this rejection, the Examiner states that Rutledge et al. teach the use of a loop for the purpose of feeding a continuous web through a plurality of stations; without applying undesirable tension as a result of the web being stopped while at a first station and continuously fed at a second station. The Examiner then alleges that the first suggestion that McCole could be combined with Rutledge et al. is McCole's disclosure of a continuous web through a plurality of stations.

The Examiner further states that McCole's continuous web performs a cycle of stop and go wherein the web is fed at a desired rate, completely stopped for treatment on the web at various stations, then fed at the desired rate. This cycle continues throughout the process of the continuous web into a film unit.

The Examiner then concludes that that the modification of McCole to include the loop(s) of Rutledge et al. would allow the web of McCole to be fed continuously upstream of the intermittent sealing and cutting station, thereby only allowing the web to be stopped while at the sealing and cutting station.

Nonetheless, Applicants respectfully submit that the Examiner's conclusion is based on the disclosure and teaching of the present application, rather than any motivation, suggestion or teaching of the desirability of making the specific combination in either McCole or Rutledge et al. That is, the Examiner still provides no reference of how or where the *patents themselves* suggest or teach this combination.

Applicants note that "[a]lthough the suggestion to combine references may flow from the nature of the problem, 'defining the problem in terms of its solution reveals improper hindsight

in the selection of the prior art relevant to obviousness.” *Exolochem, Inc. v. Southern California Edison Co.*, 227 F.3d 1361, 1363 (Fed. Cir. 2000) (citing *Monarch Knitting Mach. Corp. v. Sulzer Morat GmbH*, 139 F.3d 877, 880 (Fed. Cir. 1998). “Therefore, when determining the patentability of a claimed invention which combines two known elements, the question is whether there is something in the prior art as a whole to suggest the desirability, and thus obviousness, of making the combination.” *Id.* (citing *In re Beattie*, 974 F.2d 1309, 1311-12, (Fed. Cir. 1992)).

Thus, Applicants submit that the Examiner has improperly rejected the claims for at least two reasons. First, analogous to *Exolochem*, the Examiner has defined the problem in terms of the solution, revealing improper hindsight in the selection of the prior art relevant to obviousness. As stated above, there is no teaching or suggestion in the patents themselves of making this specific combination.

Second, case law provides that the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991) (see also MPEP 2143). As such, Applicants submit that the rejection is “hindsight reconstruction” since the *only* basis for achieving the claimed invention from the combination of McCole and Rutledge et al, as proposed by the examiner, would be impermissible hindsight reliance upon Applicants’ own teaching in the present application.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the

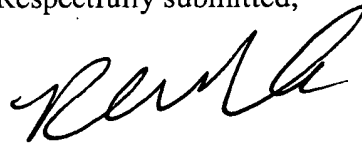
RESPONSE UNDER 37 C.F.R. § 1.116
U.S. Application No. 09/895,195

Attorney Docket No. Q65225

Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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